



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,272	08/31/2000	Sanford M. Stevenson	1843-A-DIV-CIP-DIV	2794

7590 10/24/2003

Sand & Sebolt
Suite 194
Aston Park Professional Centre
4801 Dressler Rd NW
Canton, OH 44718

EXAMINER

HRUSKOCI, PETER A

ART UNIT	PAPER NUMBER
----------	--------------

1724

22

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Daniel J. Long
Sand & Sebolt
Suite 194
Aston Park Professional Centre
4801 Dressler Rd NW
Canton, OH 44718

(Attorney for Applicant)

COPY MAILED

OCT 24 2003

OFFICE OF PETITIONS

In re Application of :
Sanford M. Stevenson :
Application No. 09/652,272 : REQUIREMENT FOR INFORMATION
Filed: August 31, 2000 :
Attorney Docket No. 1843-A-DIV-CIP-DIV :

On July 31, 2001, a petition under 37 CFR 1.292 to institute public use proceedings against the claims in the above-identified application was filed. The petition was accompanied by, inter alia, proof of service, the petition fee set forth in 37 CFR 1.17(j), and Exhibits A-H. On July 31, 2001, a protest under 37 CFR 1.291 was also filed. The protest was accompanied by Exhibits A-G.

On August 21, 2001, applicant filed a request for continued examination (RCE) under 37 CFR 1.114. The RCE was accompanied by a submission and the fee for filing an RCE. Since the RCE withdraws the notice of allowance, the petition under 37 CFR 1.292 (and the protest) is timely.

Thereafter, applicant filed requests for extension of time to file a response to the petition and protest on September 20, 2001, September 24, 2001, October 12, 2001, and December 17, 2001.

On January 18, 2002, applicant filed a response to the petition to institute public use proceedings and the protest and a request for extension of time to file the response. The response states that "[r]eferences to numerical exhibits herein should be understood to mean the exhibits attached to the Petition under 37 C.F.R. § 1.292." The petition, however, contains Exhibits A-H which do not correspond in any way to the numerical exhibits referred to in the response to the petition. For example, some of the exhibits referred to in the response to the petition appear to be trial transcripts but no trial transcripts are part of the petition. No numerical exhibits referred to in the response to the petition have been submitted. In the response, applicant requested, in the alternative, if the petition under 37 CFR 1.292 and the protest under 37 CFR 1.291 were not dismissed, that action on the application be suspended under 37 CFR 1.103(a) until the conclusion of the litigation.

Accordingly, on October 29, 2002, in a telephone communication between Ms. Eugenia Jones, Senior Legal Advisor, and Mr. Daniel J. Long, applicant's attorney, Ms. Jones requested that Mr. Long submit the exhibits referred to in the response filed January 18, 2002, and provide an update on the status of the

litigation. In addition, since Mr. Long indicated that he no longer worked at Sand & Sebolt, Ms. Jones suggested that applicant may want to submit a change of correspondence address. Mr. Long agreed to send in the requested papers including a change of correspondence address.

On July 18, 2003, in a second telephone communication, Ms. Jones requested that Mr. Long submit the papers previously requested in the first telephone communication. Mr. Long again agreed to send in the requested papers including a change of correspondence address.

To date, applicant has not filed the requested papers. Furthermore, no change of correspondence address has been submitted.

Accordingly, applicant is given **ONE MONTH** from the mail date of this letter to submit: (1) all of the exhibits referred to in the response to the petition filed January 18, 2002, and (2) a **complete** update on the status of the litigation. For example, a complete status update would include an identification and discussion of Chemical Separation Technology, Inc. v. United States, 51 Fed. Cl. 771, 63 U.S.P.Q. 2d (BNA) 1114 (2002) as well as an identification and discussion of everything that has occurred subsequent to this decision (e.g., an indication as to whether a joint status report was filed by the parties indicating how the case should proceed, along with a proposed schedule, as was ordered by the court, and a discussion of how the case has proceeded since that time). A change of correspondence address should also be submitted if applicant does not want correspondence to continue to be mailed to the above correspondence address of record. This time period is **NOT** extendable under 37 CFR 1.136(a). **Failure to provide a complete update on the status of the litigation within this time period will result in ABANDONMENT of the application. Failure to provide all of the exhibits referred to in the response to the petition within this time period will result in the response (including any arguments therein) not being considered.** Furthermore, if applicant submits the exhibits after the expiration of this time period, the submission of the exhibits will be considered untimely and the exhibits will not be considered. In view of the two telephone communications and the fact that applicant has had ample opportunity to submit the requested papers in the nearly one year between the first telephone communication referenced above and the mail date of this letter, a one month time period is deemed a sufficient time period for submitting the requested papers.

Telephone inquiries specific to this matter should be directed to Eugenia Jones, Senior Legal Advisor, at (703) 306-5586.



Fred A. Silverberg
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Cameron Elliot
Commercial Litigation Branch
Civil Division
Department of Justice
Washington, D.C. 20530

(Attorney for Petitioner)

In re Application of :
[] :
Application No. [] : REQUIREMENT FOR INFORMATION
Filed: [] :
Attorney Docket No. [] :

On July 31, 2001, a petition under 37 CFR 1.292 to institute public use proceedings against the claims in the above-identified application was filed. The petition was accompanied by, *inter alia*, proof of service, the petition fee set forth in 37 CFR 1.17(j), and Exhibits A-H. On July 31, 2001, a protest under 37 CFR 1.291 was also filed. The protest was accompanied by Exhibits A-G.

On August 21, 2001, applicant filed a request for continued examination (RCE) under 37 CFR 1.114. The RCE was accompanied by a submission and the fee for filing an RCE. Since the RCE withdraws the notice of allowance, the petition under 37 CFR 1.292 (and the protest) is timely.

Thereafter, applicant filed requests for extension of time to file a response to the petition and protest on September 20, 2001, September 24, 2001, October 12, 2001, and December 17, 2001.

On January 18, 2002, applicant filed a response to the petition to institute public use proceedings and the protest and a request for extension of time to file the response. The response states that "[r]eferences to numerical exhibits herein should be understood to mean the exhibits attached to the Petition under 37 C.F.R. § 1.292." The petition, however, contains Exhibits A-H which do not correspond in any way to the numerical exhibits referred to in the response to the petition. For example, some of the exhibits referred to in the response to the petition appear to be trial transcripts but no trial transcripts are part of the petition. No numerical exhibits referred to in the response to the petition have been submitted. In the response, applicant requested, in the alternative, if the petition under 37 CFR 1.292 and the protest under 37 CFR 1.291 were not dismissed, that action on the application be suspended under 37 CFR 1.103(a) until the conclusion of the litigation.

Accordingly, on October 29, 2002, in a telephone communication between Ms. Eugenia Jones, Senior Legal Advisor, and Mr. Daniel J. Long, applicant's attorney, Ms. Jones requested that Mr. Long submit the exhibits referred to in the response filed January 18, 2002, and provide an update on the status of the litigation. In addition, since Mr. Long indicated that he no longer worked at Sand & Sebolt, Ms. Jones

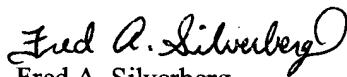
suggested that applicant may want to submit a change of correspondence address. Mr. Long agreed to send in the requested papers including a change of correspondence address.

On July 18, 2003, in a second telephone communication, Ms. Jones requested that Mr. Long submit the papers previously requested in the first telephone communication. Mr. Long again agreed to send in the requested papers including a change of correspondence address.

To date, applicant has not filed the requested papers. Furthermore, no change of correspondence address has been submitted.

Accordingly, applicant is given **ONE MONTH** from the mail date of this letter to submit: (1) all of the exhibits referred to in the response to the petition filed January 18, 2002, and (2) a **complete** update on the status of the litigation. For example, a complete status update would include an identification and discussion of Chemical Separation Technology, Inc. v. United States, 51 Fed. Cl. 771, 63 U.S.P.Q. 2d (BNA) 1114 (2002) as well as an identification and discussion of everything that has occurred subsequent to this decision (e.g., an indication as to whether a joint status report was filed by the parties indicating how the case should proceed, along with a proposed schedule, as was ordered by the court, and a discussion of how the case has proceeded since that time). A change of correspondence address should also be submitted if applicant does not want correspondence to continue to be mailed to the above correspondence address of record. This time period is **NOT** extendable under 37 CFR 1.136(a). **Failure to provide a complete update on the status of the litigation within this time period will result in ABANDONMENT of the application. Failure to provide all of the exhibits referred to in the response to the petition within this time period will result in the response (including any arguments therein) not being considered.** Furthermore, if applicant submits the exhibits after the expiration of this time period, the submission of the exhibits will be considered untimely and the exhibits will not be considered. In view of the two telephone communications and the fact that applicant has had ample opportunity to submit the requested papers in the nearly one year between the first telephone communication referenced above and the mail date of this letter, a one month time period is deemed a sufficient time period for submitting the requested papers.

Telephone inquiries specific to this matter should be directed to Eugenia Jones, Senior Legal Advisor, at (703) 306-5586.


Fred A. Silverberg
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Daniel J. Long
Sand & Sebolt
Suite 194
Aston Park Professional Centre
4801 Dressler Rd NW
Canton, OH 44718

(Attorney for Applicant)